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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,672	02/09/2004	Ke-Chi Jang	22171.319	9436
27683	7590	10/05/2005	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			PEACHES, RANDY	
			ART UNIT	PAPER NUMBER
			2686	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/774,672	JANG ET AL.	
	Examiner	Art Unit	
	Randy Peaches	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/28/05, 9/14/04, 8/2/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. ***Claims 1-7*** are rejected under 35 U.S.C. 101 because claimed invention is directed to non-statutory subject matter.

Regarding ***claim 1***, the Applicant claims a "computer signal," which is directed to an intangible information element that is only expressed in the Applicant's disclosure once on page 2, line 2 without any examples further explaining its relevance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. ***Claims 1-7*** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, "computer signal," which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specification

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. ***Claims 8-28*** are rejected under 35 U.S.C. 102(b) as being anticipated by Havinis et al. (U.S. Patent Number 6,311,069 B1).

Regarding ***claim 8***, Havinis et al. discloses a telecommunication system, which reads on claimed "wireless communication system," comprising:

- a station having communication logic, which reads on claimed "software," for: receiving a capability request, wherein capability request is interpreted as information regarding location or position information of a mobile station (MS, 20). See column 3 lines 56-62 and column 4 lines 26-30; and
- generating and transmitting a capability request response that includes a status indicator of a non-emergency-services position-determination (NESPDP) capability, wherein the NESPDP capability is user-selectable. See column 6 lines 4-22 and lines 42-50.

Regarding ***claim 9***, according to ***claim 8***, Havinis et al. continues to disclose wherein the capability request response further includes at least one of a GPS acquisition capability indicator and a position calculation capability indicator. See column 2 lines

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28-41.

Regarding **claim 10**, according to **claim 8**, Havinis et al. continues to disclose wherein the station is a first said MS (20) and the communication logic is first receiving logic (24), the said telecommunication system further comprising a second station, MSC (14) having second communication logic (13) for generating and transmitting the capability request. See column 5 lines 27-29.

Regarding **claim 11**, according to **claim 10**, Havinis et al. continues to disclose wherein the said MSC (14) comprises positioning logic, which reads on claimed "position determining element." See column 6 lines 31-37.

Regarding **claim 12**, according to **claim 8**, Havinis et al. continues to disclose wherein the station is a said MS (20). See column 4 lines 49-53.

Regarding **claim 13**, according to **claim 8**, Havinis et al. continues to disclose wherein the said station is selected from the group consisting of: a cellular phone, a wireless enabled personal digital assistant, a wireless-enabled personal computer, a GPS device, and a pager. Havinis et al. discloses a cellular phone. See column 1 lines 39-43.

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Regarding **claim 14**, Havinis et al. discloses a method of communicating between telecommunications network stations, comprising:

- receiving at a MS (20) a capability request transmitted by a MSC (14). See column 5 lines 27-40;
- generating at the said MS (20) a capability request reply in response to the capability request, wherein the capability request reply includes a status indicator of a non-emergency-services position-determination (NESPd) capability of said MS (20), the NESPd capability being user-selectable. See column 6 lines 1-12; and
- transmitting the capability request reply to the said MSC (14). See column 6 lines 4-12.

Regarding **claim 15**, according to **claim 14**, Havinis et al. continues to disclose wherein further comprising:

- generating the capability request at the said MSC (14). See column 5 lines 66-67;
- transmitting the capability request from the said MSC (14) to the said MS (20). See column 5 lines 27-36; and
- receiving the capability request reply at the second station. See column 6 lines 4-12.

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Regarding **claim 16**, according to **claim 14**, Havinis et al. continues to disclose selecting the NESPD capability, wherein the said MS (20) has the option to accept or reject the request. See column 6 lines 13-22.

Regarding **claim 17**, according to **claim 16**, Havinis et al. continues to disclose wherein the NESPD capability is selected by the said MS (20) user. See column 6 lines 13-22.

Regarding **claim 18**, according to **claim 14**, Havinis et al. continues to disclose wherein the said MSC (14) comprises a HLR (26), which reads on claimed "stationary position determining element," and the said MS (20) comprises a wireless mobile device. See column 1 lines 39-43 and column 6 lines 61-67.

Regarding **claim 19**, according to **claim 14**, Havinis et al. continues to disclose wherein the capability request reply comprises MS (20) identity, which is either and accept or reject response (column 6 lines 14-22), including at least one of a GPS acquisition capability indicator and a position calculation capability indicator. See column 2 lines 28-41.

Regarding **claim 20**, according to **claim 14**, Havinis et al. continues to disclose wherein generating a position determination request at the said MSC (14) and transmitting the position determination request to the said MS (20) based on an accept of reject

response. See column 6 lines 31-38.

Regarding **claim 21**, according to **claim 14**, Havinis et al. continues to disclose wherein terminating position determination activity at the said MSC (14) based on a default of reject response from the said MS (20). See column 6 lines 23-31.

Regarding **claim 22**, Havinis et al. discloses a mobile station (MS, 20), comprising:

- a display (27), which reads on claimed "user-interface," for selecting a non-emergency-services position-determination (NESPd) capability. See column 5 lines 37-40;
- a generator configured to generate a signal, wherein the signal can one of a tone or display of the requesting LA (column 5 lines 32-37) comprising a status indicator of the NESPd capability and zero or more wireless mobile device native capability data; and
- a transmitter configured to transmit the signal to a wireless network element.

See column 6 lines 7-12.

Regarding **claim 23**, according to **claim 22**, Havinis et al. continues to disclose wherein the transmitter is configured to transmit the signal based on an external request received from a wireless network element. See column 6 lines 13-22.

Regarding **claim 24**, according to **claim 14**, Havinis et al. continues to disclose wherein

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the transmitter of the said MSC (14) when a default response is received by the said MS (20), is configured to transmit the signal based on stimulus exclusive of an external request for the status of the NESPD capability. See column 6 lines 23-27.

Regarding **claim 25**, according to **claim 24**, Havinis et al. continues to disclose wherein the stimulus comprises a position-related request, which the said MS (20) has rejected. See column 6 lines 13-22.

Regarding **claim 26**, according to **claim 22**, Havinis et al. continues to disclose wherein the transmitter is configured to transmit the signal based on a stimulus comprising an external request for the status of the NESPD capability by responding immediately to a request by either accepting or rejecting the request. See column 6 lines 13-22.

Regarding **claim 27**, according to **claim 22**, Havinis et al. continues to disclose wherein the zero or more is one or more. See column 3 lines 62-67.

Regarding **claim 28**, according to **claim 22**, Havinis et al. continues to disclose wherein the said MS (20) is selected from the group consisting of: a mobile telephone; a personal computer with a wireless modem; a GPS device; a pager; and a wireless-enabled PDA. Havinis et al. discloses a cellular phone. See column 1 lines 39-43.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (571) 272-7914. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Randy Peaches
September 28, 2005

Marsha D Banks-Harold
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